



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

ED

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/145,987 09/03/98 NAKANISHI Y 2224-0142P

002292 HM22/0621
BIRCH STEWART KOLASCH & BIRCH
P O BOX 747
FALLS CHURCH VA 22040-0747

EXAMINER

WHITE, E	
ART UNIT	PAPER NUMBER

1623
DATE MAILED:

17
06/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/145,987

Applicant(s)
NAKANISHI et al.

Examiner
Everett White

Group Art Unit
1623



☒ Responsive to communication(s) filed on May 26, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-13 and 15-22 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-13 and 15-22 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. The request filed on May 26, 2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/145,987 is acceptable and a CPA has been established. An action on the CPA follows.
2. Amendment D filed April 20, 2000 has been received and entered into the record.
3. Claims 1-13 and 15-22 are pending in the case.
4. All 35 U.S.C. statutes not cited in this Office action can be found cited in full in a previous Office action.

35 U.S.C. 103 Rejection

5. Claims 1-13 and 15-22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ishii et al (US Patent No. 3,816,150) for the reasons already of record on pages 4 and 5 of the Office action mailed February 25, 1999.
6. Applicant's arguments filed April 20, 2000 have been fully considered but they are not persuasive. Applicants argue against the rejection on the grounds that the Ishii et al patent fail to teach the characteristics (i)-(iii) of the present invention. This argument is not persuasive since the Ishii et al patent does indeed teaches a cellulose acetate comprising at least one the claimed characteristics. For example, Claim 1 reads on a cellulose acetate whereby feature (ii) may be selected, wherein feature (ii) is further limited to features of the cellulose acetate which may be selected to be a cellulose acetate which contains an acid having an acid dissociation exponent pK_a of 1.93 to 4.50 in water. See page 14, line 18 to page 15, line 23 of the instant specification for examples of aliphatic monocarboxylic acids that have an acid dissociation exponent pK_a within the claimed 1.93 to 4.50 value in water that may be present with the claimed cellulose acetate. The list includes acetic acid and succinic acid, both of which are disclosed with the cellulose acetate of the Ishii et al patent. Accordingly, the rejection of Claims 1-13 and 15-22 under 35 U.S.C. 103(a) as being unpatentable over the Ishii et al patent is maintained.

7. Claims 18-21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Seo et al (US Patent No. 5,240,665) in view of Ishii et al (US Patent No. 3,816,150) for the reasons already of record on page 5 of the Office action mailed February 25, 1999.

8. Applicant's arguments filed April 20, 2000 have been fully considered but they are not persuasive. The Seo et al patent is cited to show that the presence and use of a dope with cellulose acetate, as set forth in instant claims 18-21, is well known in the art. The patentability of instant claims 18-21 are dependent upon the patentability of the instantly claimed cellulose acetate as set forth in instant claim 1. However, as discussed in the above rejection, the cellulose acetate ^{es} do not appear to be patentable over the Ishii et al patent. Therefore, the rejection of claims 18-21 under 35 U.S.C. 103(a) as being unpatentable over the Seo et al and Ishii et al patent is also maintained for the reasons disclosed in the above art rejection over the Ishii et al patent alone.

9. All the claims are rejected.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. White whose telephone number is (703) 308-4621. The examiner can normally be reached on Monday-Friday from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Geist, can be reached on (703) 308-1701. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

E. White

White
June 18, 2000



GARY GEIST
SUPERVISORY PATENT EXAMINER
TECH CENTER 1600